

GL.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,965	02/04/2004	William Green	GREEN-1	3856

7590 08/11/2004

Connolly Bove Lodge & Hutz LLP
P.O. Box 2207
Wilmington, DE 19899-2207

EXAMINER

CARTER, MONICA SMITH

ART UNIT	PAPER NUMBER
----------	--------------

3722

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/771,965

Applicant(s)

GREEN ET AL.

Examiner

Monica S. Carter

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/04/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-16 and 18-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mahoney (2004/0088893).

Mahoney discloses a greeting card having a first side (as seen in figure 2) and an opposite second side (as seen in figure 3), a drawing (6) and accompanying greeting (7) on the first side, a transparent window (8) formed in the substrate creating an absence of the drawing and greeting to provide an area which can be replaced by a user's digits to create a 3-D affect.

Regarding claims 1, 3, 4, 12 and 14-16, Mahoney discloses the claimed invention except for the specific arrangement and/or content of indicia (for example, "a depiction of a person", "said portion of said anatomy is the buttocks", "said portion of the anatomy is the breasts", "information about the depicted person", "said window is at least partially surrounded by clothing on the depicted person", "said depicted person is a female" and "said depicted person is a male") set forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired indicia on the greeting card, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that

when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of greeting card does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

Regarding the limitation "...to simulate the absent portion in an appearance of bare skin", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the card of Mahoney is capable of performing the intended use as claimed.

Regarding claim 5, the substrate is made of stiff shape-retaining material (as seen in figure 1, the card is made of a stiff material that enables the card to be positioned in a tent-style arrangement).

Regarding claim 6, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the card of any desired material (to

include a laminate), since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 7, the substrate is of a size between a business card to an index card (as seen in figure 1).

Regarding claims 8, 10 and 11, Mahoney discloses the claimed invention except for the claimed dimensions of the card. It would have been an obvious matter of design choice to provide any desired dimensions for the card, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claim 9, the card is a business card (greeting cards provide a business of advertising).

Regarding claim 13, the card has printed material on both the first and second sides (as seen in figures 2 and 3).

Regarding claim 18, the card is a greeting card.

Regarding claim 19, the greeting card has a front (page having characters 10) and a back page (page having windows 8) and a window in the back page (as seen in figure 3).

Regarding claims 20-29, the method of providing an entertainment card is disclosed in the above rejections to claims 1-19.

3. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mahoney in view of Zeisky et al. (5,192,093).

Mahoney discloses the claimed invention except for the card having a transparent shield across the window.

Zeisky et al. disclose a card having a cutout (44) with a transparent sheet (46) covering the window (as seen in figures 4 and 5). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the card of Mahoney to include a transparent shield, as taught by Zeisky et al., to provide a protective covering for the window on the card.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references disclose card substrates.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (6:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone

Art Unit: 3722

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 6, 2004

Monica S. Carter
MONICA S. CARTER
PRIMARY EXAMINER